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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,044	07/18/2003	Qi Qu	020569-02600	6445

7590 09/20/2005

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EXAMINER

HRUSKOCI, PETER A

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/623,044

Applicant(s)

QU ET AL.

Examiner

Peter A. Hruskoci

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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Claims 1-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1 “capable of discriminating” is vague and indefinite because it is unclear how this term further limits the claim. In claim 1 “the complex metal precipitate” and “the brine solution” lack clear antecedent basis. In claim 40 “ethylenediaminetetraacetic acid” does not appear to further limit the group of chelants in claim 39. Claim 2-39, and 41-57 depend from the above claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 8, 10, 11, 13-15, 27, 52, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darlington et al. 4,465,598 in view of Barthrope 5,302,297. Darlington et al. disclose (see col. 1 line 6 through col. 3 line 57) a method of reclaiming a well completion brine substantially as claimed. The claims differ from Darlington et al. by reciting that the brine is mixed with an organic chelant. Barthrope et al. disclose (see col. 2 line 48 through col. 4 line 46) that it is known in the art to add an organic chelant to a brine from a production well bore, to aid in forming insoluble salt precipitates in the brine solution. It would have been obvious to one skilled in the art to modify the method of Darlington et al. by addition of the recited chelant in view of the teachings of Barthrope et al., to aid in removing insoluble salt precipitates from the brine.

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Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Darlington et al. 4,465,598 in view of Barthrope 5,302,297 as above, and further in view of Dobson et al. 5,783,527. The claims differ from the references as applied above by reciting that the oxidizer in calcium or magnesium peroxide. Dobson et al. disclose (see col. 2 line 51 through col. 5 line 50) that it is known in the art to add the recited peroxides to a well completion brine, to aid in liberating hydrogen peroxide in the brine. It would have been obvious to one skilled in the art to modify the references as applied above, by addition of the recited peroxides in view of the teachings of Dobson et al., to aid in oxidizing metal ions in the brine.

Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Darlington et al. 4,465,598 in view of Barthrope 5,302,297 and Dobson et al. 5,783,527 as above, and further in view of Skee et al. 5,989,353. The claim differs from the references as applied above by reciting that the organic chelant is benzoic acid. Skee al. disclose (see col. 6 lines 1-23) that it is known in the art to utilize benzoic acid as a metal chelating agent. It would have been obvious to one skilled in the art to modify the references as applied above, by addition of the recited chelant in view of the teachings of Skee et al., to aid in removing insoluble precipitates from the brine.

Claims 9, 12, 20-23, 27, 31-33, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darlington et al. 4,465,598 in view of Barthrope 5,302,297 as above, and further in view of Skee et al. 5,989,353. The claims differ from the references as applied above by reciting the use of specific organic chelants. Skee al. disclose (see col. 6 lines 1-23) that it is known in the art to utilize the recited chelants to aid in chelating metal in solutions. It would have been obvious to one skilled in the art to modify the references as applied above, by addition

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of the recited chelants in view of the teachings of Skee et al., to aid in removing insoluble precipitates from the brine.

Claims 15-19 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darlington et al. 4,465,598 in view of Barthrope 5,302,297 as above, and further in view of Crudden et al. 5,821,215. The claims differ from the references as applied above by reciting that the use of specific organic chelants. Crudden al. disclose (see col. 2 line 5 through col. 4 line 59) that it is known in the art to utilize the recited chelants to aid in chelating or sequestering heavy metal ions in solutions. It would have been obvious to one skilled in the art to modify the references as applied above, by addition of the recited chelants in view of the teachings of Crudden et al., to aid in removing insoluble precipitates from the brine.

Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Darlington et al. 4,465,598 in view of Barthrope 5,302,297 and Crudden et al. 5,821,215 as above, and further in view of Simon et al 4,507,208. The claim differs from the references as applied above by reciting that the addition of an absorbent to the brine. Simon et al. disclose (see col. 3 line 3 through col. 6 line 61) that it is known in the art to add activated charcoal to drilling fluids, to aid in absorbing organic materials from the fluid. It would have been obvious to one skilled in the art to modify the references as applied above, by addition of the recited absorbent in view of the teachings of Simon et al., to aid in removing organic materials from the brine.

Claims 24 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darlington et al. 4,465,598 in view of Barthrope 5,302,297 as above, and further in view of Amiya et al. 6,335,398. The claims differ from the references as applied above by reciting that the use of specific organic chelants. Amiya et al. disclose (see col. 4 line 19 through col. 10 line

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45) that it is known in the art to utilize the recited chelants to aid in chelating metal ions in solutions. It would have been obvious to one skilled in the art to modify the references as applied above, by addition of the recited chelant in view of the teachings of Amiya et al., to aid in removing insoluble precipitates from the brine.

Claims 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Darlington et al. 4,465,598 in view of Barthrope 5,302,297 as above, and further in view of Amano et al. 4,908,080. The claim differ from the references as applied above by reciting that the use of a specific organic chelant . Amano et al. disclose (see col. 3 lines 53-65) that it is known in the art to utilize the recited chelant to aid in inorganic salt solutions. It would have been obvious to one skilled in the art to modify the references as applied above, by addition of the recited chelant in view of the teachings of Amiya et al., to aid in removing insoluble precipitates from the brine.

Claims 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Darlington et al. 4,465,598 in view of Barthrope 5,302,297 as above, and further in view of Nagai et al. 4,559,216. The claim differ from the references as applied above by reciting that the use of a specific organic chelant . Nagai et al. disclose (see col. 3 lines 2-48) that it is known in the art to utilize the recited chelant to aid in chelating metal ions in solutions. It would have been obvious to one skilled in the art to modify the references as applied above, by addition of the recited chelant in view of the teachings of Nagai et al., to aid in removing insoluble precipitates from the brine.

Claims 31, 32, 34-37, 41, and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darlington et al. 4,465,598 in view of Barthrope 5,302,297 as above, and further in view of Kawasaki al. 6,139,973. The claims differ from the references as applied

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above by reciting that the use of specific organic chelants. Kawasaki et al. disclose (see col. 9 lines 15-41) that it is known in the art to utilize the recited chelants to aid in chelating metal ions in solutions. It would have been obvious to one skilled in the art to modify the references as applied above, by addition of the recited chelants in view of the teachings of Kawasaki et al., to aid in removing insoluble precipitates from the brine.

Claims 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darlington et al. 4,465,598 in view of Barthrope 5,302,297 as above, and further in view of Anderson et al. 6,758,967. The claims differ from the references as applied above by reciting that the use of specific organic chelants. Anderson et al. disclose (see col. 3 line 35 through col. 7 line 35) that it is known in the art to utilize the recited chelants, to aid in chelating metal ions in solutions. It would have been obvious to one skilled in the art to modify the references as applied above, by addition of the recited chelants in view of the teachings of Anderson et al., to aid in removing insoluble precipitates from the brine.

Claims 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darlington et al. 4,465,598 in view of Barthrope 5,302,297 as above, and further in view of Horton et al. 5,211,859. The claims differ from the references as applied above by reciting that the use of specific organic chelants. Horton et al. disclose (see col. 3 line 62 through col. 4 line 4) that it is known in the art to utilize the recited chelants to aid in chelating aluminum ions in solutions. It would have been obvious to one skilled in the art to modify the references as applied above, by addition of the recited chelants in view of the teachings of Horton et al., to aid in removing insoluble precipitates from the brine.

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Claims 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darlington et al. 4,465,598 in view of Barthrope 5,302,297 as above, and further in view of Horiguchi et al. 4,317,882. The claims differ from the references as applied above by reciting that the use of specific organic chelants. Horiguchi et al. disclose (see col. 3 line 64 through col. 4 line 11) that it is known in the art to utilize the recited chelants to aid in chelating metal ions in solutions. It would have been obvious to one skilled in the art to modify the references as applied above, by addition of the recited chelants in view of the teachings of Horiguchi et al., to aid in removing insoluble precipitates from the brine.

Claims 54 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darlington et al. 4,465,598 in view of Barthrope 5,302,297 as above, and further in view of Simon et al 4,507,208. The claims differ from the references as applied above by reciting that the addition of an absorbent to the brine. Simon et al. disclose (see col. 3 line 3 through col. 6 line 61) that it is known in the art to add activated charcoal to drilling fluids, to aid in absorbing organic materials from the fluid. It would have been obvious to one skilled in the art to modify the references as applied above, by addition of the recited absorbent in view of the teachings of Simon et al., to aid in removing organic materials from the brine.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of

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record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 8, 15-19, 39, 40, and 52-57 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 11/145,281. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method steps recited in the instant claims appear to be encompassed by the claims of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

It is noted since the inventive entities of the above applications are different, applicants should verify that the inventions were commonly owned at the time the inventions were made.


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter A. Hruskoci whose telephone number is (571) 272-1160. The examiner can normally be reached on Monday through Friday from 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Peter A. Hruskoci
Primary Examiner
Art Unit 1724

9/15/05